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EXAMINER				
BRIER, JEFFERY A				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

09/934,479

**Applicant(s)**

FUJIWARA ET AL.

**Examiner**

Jeffery A. Brier

**Art Unit**

2628

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 31 August 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3-9,11-15,17-34 and 42-47 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-9,11-15,17-34 and 42-47 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SE/C.3)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 08/31/2010 has been entered.

### ***Response to Amendment***

2. The amendment filed on 08/31/2010 has been entered.

### ***Response to Arguments***

3. Applicant's arguments concerning 35 USC 112 second paragraph rejections filed 08/31/2010 have been fully considered but they are not persuasive. At pages 16-19 applicants arguments only argues the means plus function device claims and does not present any arguments concerning the computer readable medium claims, the method claims, and the circuit for device claims. Additionally the arguments submitted for the means plus function device claims are non-limiting open ended arguments, e.g. "However, the claim is not limited to the specific disclosed embodiment". Thus, the claims do cover more than step 101 and cover step 101, step 102, the step between step 101 and step 102 (see applicants specification at page 9 lines 9-11 which discusses step performed by mark detecting section 171), the step before step 101, and

step 103. Thus, applicants arguments alone are not persuasive to overcome the 35 USC 112 second paragraph rejection set forth in the office action mailed on 04/02/2010. Positive amendments to the claims are needed to clarify the metes and bounds of the claims.

4. Applicant's amendments and arguments concerning 35 USC 101 rejections filed 08/31/2010 have been fully considered but they are not persuasive. At page 19 applicant addresses the 35 USC 101 rejection set forth in the office action mailed on 04/02/2010 by making reference to the amendment to claim 17. Applicant amended claim 17 to claim "using an electronic circuit" which does not limit the method steps to a particular machine because the extent the electronic circuit performs the step is open ended, thus, "using an electronic circuit" amendment does not overcome the 35 USC 101 rejection set forth in the office action mailed on 10/09/2009.

5. In summary the 35 USC 101 rejection set forth in the office action mailed on 04/02/2010 is maintained and reproduced below with modification to reflect claim amendments to method claim 17 and the 35 USC 112 second paragraph rejection set forth in the office action mailed on 04/02/2010 is maintained and reproduced below with modification. Additionally the Examiner has identified below an additional indefinite issue with regard to independent claims 3, 5, 11, and 13.

***Claim Rejections - 35 USC § 101***

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 17, 24-26, 30, and 44 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Method claims 17, 24-26, 30, and 44:

Based upon consideration of all of the relevant factors with respect to the claim as a whole, claim 17 is held to claim an abstract idea, and is therefore rejected as ineligible subject matter under 35 U.S.C. § 101. The rationale for this finding is explained below:

Method claim 17 does not claim patent eligible subject matter because method claim 17:

- (1) is not tied to another statutory category (such as a particular apparatus);
- (2) does not transform underlying subject matter (such as an article or material) to a different state or thing; and
- (3) the mechanism by which the claim's abstract idea steps are implemented is subjective or imperceptible, see Federal Register Vol. 75, No. 142, Tuesday, July 27, 2010 at page 43927 second and third columns under heading of Factors Weighing Against Eligibility.

The 08/31/2010 amendment amended claim 17 to claim "using an electronic circuit" which does not limit the method steps to a particular machine because the extent the electronic circuit performs the step is open ended, thus, "using an electronic

circuit" amendment does not limit the claim to patent eligible subject matter because this step may only be presenting information for the human operator allowing the human operator to perform the abstract idea of reconstructing and laying out.

The 02/02/2010 amendment amended claim 17 to claim in the extra-solution detecting step "by using a scanner to scan a document" which extra-solution detecting step does not limit the digital image processing method steps to a particular machine, thus, the detecting step amendment does not satisfy the machine or transformation test.

Dependent claims 24-26, 30, and 44 when analyzed as a whole are held to be ineligible subject matter and are rejected under 35 U.S.C. § 101 because the additional recited limitations fail to establish that the claims are not directed to an abstract idea, as detailed below:

Claims 24-26 merely define the characteristics of the document. Claims 30 and 44 merely define the characteristics of the reconstructed document.

Therefore, these method claims do not tie the method to 1) a particular apparatus because the actor of these steps may be the human operator who performs the claimed abstract mathematical steps or 2) transform underlying subject matter because no physical transformation is claimed or 3) the mechanism by which the claim's abstract mathematical steps are implemented is subjective or imperceptible.

***Claim Rejections - 35 USC § 112***

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 1, 3-9, 11-15, 17-34, and 42-47 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Independent claims 3, 5, 11, and 13:

All of the independent claims claim "a user selection of a plurality of document blocks" while some independent claims claim extracting the plurality of document blocks (claims 1, 9, 17, 27, 32, and 33) while other independent claims claim extracting the document block (claims 3, 5, 11, and 13). Claims 3 and 5 are indefinite because which document block is extracted in the claimed extracting the document block of the plurality of document blocks is unclear. Claims 11 and 13 are indefinite because which document block is extracted in the claimed extract the document block of the plurality of document blocks is unclear.

The dependent claims of these claims do not correct this issue.

Independent claims 1, 3, 5, 9, 11, 13, 17, 27, 32, and 33:

The detecting portion of these claims may be interpreted to cover different steps of applicants specification and by drafting the claimed detecting to cover different steps the claims do not distinctly point out the invention. Independent claims 1, 3, and 5 claim "means for detecting a user selection", independent claims 9, 11, and 13 claim "detect a user selection" step, independent claim 17 claims a step of "detecting a user selection",

independent claim 27 claims "a detection circuit for detecting a user selection", and independent claims 32 and 33 claim a "circuit for: detecting a user selection". The specification describes several different steps that perform the claimed function such as step 101, step 102, the step between step 101 and step 102 (see applicants specification at page 9 lines 9-11 which discusses step performed by mark detecting section 171), the step before step 101, and step 103. The specification at page 9 lines 3-8 describes step S101 as executing "pre-scan" which scans the document which detects the mark placed on the document by the user. The specification at page 9 lines 9-11 describes the step between step 101 and step 102 which is the step performed by mark detecting section 171. The specification at page 9 lines 8-9 and 12-19 describes step S102 "In step 102, a determination is made as to whether or not a mark has been detected in the pre-scan image data.". The specification at page 9 lines 19-23 describes a step before 101 "This mark is added to the document by the user beforehand using a marker such as a felt-tip pen or the like. The user marks at least an area containing a headline and body text corresponding to the headline.". The specification at page 9 line 24 to page 10 line 3 describes step S103 "In step S103, a screen inviting the user to attach a mark to the document is displayed on the touch panel display of the operation unit 140. In this case the user appends a mark on the document, and the document block extraction process is again executed." In view of MPEP 2173.03 and 2173.05(a)(I) at page 2100-220 Original Eighth Edition, August 2001 Latest Revision July 2010, the means or steps of the specification covered by the



above quoted claim limitations is unclear due to the detecting of the claims covering more than one of the different steps described in the specification.

2173.03 Inconsistency Between Claim \*and< Specification Disclosure or Prior Art [R-1] [R-1]

Although the terms of a claim may appear to be definite, inconsistency with the specification disclosure or prior art teachings may make an otherwise definite claim take on an unreasonable degree of uncertainty. *In re Cohn*, 438 F.2d 989, 169 USPQ 95 (CCPA 1971); *In re Hammack*, 427 F.2d 1378, 166 USPQ 204 (CCPA 1970). In *Cohn*, the claim was directed to a process of treating a surface with a corroding solution until the metallic appearance is supplanted by an "opaque" appearance. Noting that no claim may be read apart from and independent of the supporting disclosure on which it is based, the court found that the description, definitions and examples set forth in the specification relating to the appearance of the surface after treatment were inherently inconsistent and rendered the claim indefinite.

2173.05(a) New Terminology [R-3]

I. THE MEANING OF EVERY TERM SHOULD BE APPARENT

The meaning of every term used in a claim should be apparent from the prior art or from the specification and drawings at the time the application is filed. Applicants need not confine themselves to the terminology used in the prior art, but are required to make clear and precise the terms that are used to define the invention whereby the metes and bounds of the claimed invention can be ascertained. During patent examination, the pending claims must be given the broadest reasonable interpretation consistent with the specification. *In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997); *In re Prater*, 415 F.2d 1393, 162 USPQ 541 (CCPA 1969). See also MPEP § 2111 - § 2111.01. When the specification states the meaning that a term in the claim is intended to have, the claim is examined using that meaning, in order to achieve a complete exploration of the applicant's invention and its relation to the prior art. *In re Zletz*, 893 F.2d 319, 13 USPQ2d 1320 (Fed. Cir. 1989).

Also Refer to the September 2, 2008 John Love memo "Indefiniteness rejections under 35 U.S.C. 112, second paragraph" discussed above in the response to arguments section of this office action.

The dependent claims of these claims do not correct this issue.

Independent claims 1, 3, 5, and 17:

Independent claims 1, 3, and 5 claim "means for detecting a user selection" and claim 17 claims a step of "detecting a user selection". Claim elements "means for detecting a user selection" and claim 17 claims a step of "detecting a user selection" is a means (or step) plus function limitation that invokes 35 U.S.C. 112, sixth paragraph. However, the written description fails to clearly link or associate the disclosed structure, material, or acts to the claimed function such that one of ordinary skill in the art would recognize what structure, material, or acts perform the claimed function for the same reasons given above for this applications different steps that perform the claimed function such as step 101, step 102, the step between step 101 and step 102 (see applicants specification at page 9 lines 9-11) which discusses step performed by mark detecting section 171, the step before step 101, and step 103. Refer to the September 2, 2008 John Love memo discussed above "Rejections under 35 U.S.C. 112, second The dependent claims of these claims do not correct this issue.

As discussed above claim element of independent claims 1, 3, and 5 "means for detecting a user selection" and of independent claim 17 "detecting a user selection" is a means (or step) plus function limitation that invokes 35 U.S.C. 112, sixth paragraph. The written description only implicitly or inherently sets forth the corresponding structure, material, or acts that perform the claimed function as discussed above.

Pursuant to 37 CFR 1.75(d) and MPEP §§ 608.01(o) and 2181, applicant is required to:

(a) Amend the claim so that the claim limitation will no longer be a means (or step) plus function limitation under 35 U.S.C. 112, sixth paragraph; or

(b) Amend the written description of the specification such that it expressly recites the corresponding structure, material, or acts that perform the claimed function and clearly links or associates the structure, material, or acts to the claimed function, without introducing any new matter (35 U.S.C. 132(a)); or

(c) State on the record what the corresponding structure, material, or acts, which are implicitly or inherently set forth in the written description of the specification, perform the claimed function.

With regard to item(c) the Examiner has discussed above that applicant has not clearly made this statement.

### ***Conclusion***

10. An analysis of the claimed invention with regard to the prior art will be held in abeyance until the claimed invention has been clarified since the metes and bounds of the claims are not definite. Thus, a prior art rejection or an indication of allowability cannot be made with the currently pending claims. In re Steele, 305 F.2d 859,134 USPQ 292 (CCPA 1962) (it is improper to rely on speculative assumptions regarding the meaning of a claim and then base a rejection under 35 U.S.C. 103 on these assumptions).

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffery A. Brier whose telephone number is (571) 272-7656. The examiner can normally be reached on M-F from 7:30 to 4:00. If attempts to

reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xiao Wu can be reached at (571) 272-7761. The fax phone Number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Jeffery A. Brier/  
Primary Examiner, Art Unit 2628